

REMARKS

Claim Rejections

Claims 1-4, 6-8, 12-22, 32-33 and 35-42 stand rejected under 35 USC 102(b) as anticipated by U.S. Patent No. 6,113,4492 (Walker).

Claims 5, 23-31 and 34 stand rejected under 35 USC 103(a) as unpatentable over Walker in view of U.S. Patent Application Publication No. 2002/0152120 (Howington). Claims 9-11 stand rejected under 35 USC 103(a) as unpatentable over Walker in view of U.S. Patent Application Publication No. 2003/00544878 (Benoy et al.).

Claim Objections

Claims 6-19 and 27 stand objected to as being of improper dependent form.

Claim Amendments

Claims 6-19 and 27 have been amended to eliminate the claim objections. Claims 44 and 45 have been added.

The Cited Art

Walker discloses a gaming system wherein a slot machine 100 operates in both a normal payout mode and a reverse payout mode. In the normal payout mode, the slot machine operates in a conventional manner. (Col. 4, lines 9-11). In the reverse payout mode, the ratio of winning outcomes to losing outcomes is greater than one. That is, the statistical likelihood of generating any winning outcome is greater than the statistical likelihood of generating any losing outcome. (Col. 5, lines 40-55).

Howington is directed to a casino management system for tracking machine history, for tracking location history, for tagging construction activity in a casino location, and for changing machine placards without losing historical machine or location information. (§0019). Figures 4-8 illustrate sample display screens for viewing and querying historical records associated with gaming machines. Specifically, Figure 4 illustrates a graphical interface for viewing, querying and retrieving placard changes and location changes for various gaming machines. (§0029). The display screen of Figure 5 provides information on machine performance as opposed to machine location, placard and revision history. (§0032). Figure 6 contains similar location, placard and machine information as is displayed in Figures 4 and 5. Figure 6 also includes information relating to wins, recorded currency amounts and counts for a particular gaming machine.

(¶0033). Figure 7 illustrates a visual analysis tool presenting machine performance information as bar graphs in a data table. (¶0038). Figure 8 demonstrates the sortability and relational features of the visual analysis in presenting comparisons between machines regarding performance, manufacturer, denomination, average daily win, total win and coin in. (¶0039) Further, Figures 10-12 illustrate casino floor layouts. Specifically, Figure 10 is an overhead two dimensional view of gaming machines on a casino floor. (¶0042). Figures 11 and 12 show possible three dimensional views of the gaming machines. (¶0048). All these figures of Howington represent displays and information used by casino management to manage and operate the various gaming machines in a casino.

Benoy et al. is directed to a gaming machine used to provide a method of registering a player to a loyalty program. (Abstract). The gaming machine may have a touch screen display 16 used as an interface to provide player tracking services and to provide other game services to a player playing a game on the gaming machine. (¶0036). A printer button 204 may be used to obtain metering information about a printer on the gaming machine that issues printed tickets that may be used to obtain gaming credits on the gaming machines or redeemed for cash. (¶0066).

Applicant's Claimed Invention Is Neither Anticipated Nor Would It Have Been Obvious

Walker does not disclose each and every limitation of independent claims 1, 35, 38, 41 and 45. Thus, these claims are not anticipated by Walker.

Further, the combination of Walker and Howington or Benoy et al. does not result in Applicant's claimed invention, as set out in dependent claims 5, 9-11, 23-31 and 34. Thus, a prima facie case of obviousness has not been made out.

More specifically, the Examiner's claim analysis and claim interpretation are flawed. Functional limitations in the claims have been ignored in evaluating the claimed invention vis-a-vis the prior art. This is an impermissible claim analysis.

Applicant is permitted to use functional language, alternative expressions, negative limitations, or any style of expression or format which defines the boundaries of the subject matter for which patent protection is sought. M.P.E.P § 2173.01. A functional limitation can be used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the claimed invention. A functional limitation, such as an intended use, is defining something by what it does, rather than by what it is. There is absolutely nothing wrong with defining an invention in functional terms. M.P.E.P § 2173.05(g).

A functional limitation must be evaluated and considered, just like any other claim limitation. M.P.E.P 2173.05(g). It is wrong to ignore such limitations in a claim. Therefore, for a valid rejection, if an invention is defined by what it does rather than by what it is, then the art relied upon must disclose, inherently or expressly, the functional characteristics of the invention. In re Swinehart, 439 F.2d. 210, 169 USPQ 226 (CCPA 1971); M.P.E.P § 2114.

Claim 1, for instance, calls for a method for communicating a report concerning a gaming machine's past payout data to a player. The method includes tracking gaming machine payout data and storing a record of the payout data in memory accessible by the gaming machine. The method further includes accepting criteria from a player such that particular payout data is selected from the record to generate a report, based on the selected payout data, which allows the player to identify a gaming machine from among a plurality of gaming machines that is more likely to produce an outcome desired by the player. The report derived from the record is communicated to the player.

As conceded in the Office Action, Walker only discloses tracking data, storing a record of data, accepting data or information, and communicating a report to a player. (Office Action, ¶6). Since Walker does not disclose each and every feature of the independent method claims, Walker cannot anticipate these claims.

Claim 41, by way of example, calls for a system for displaying the past payout data of a gaming machine. The system comprises a plurality of gaming machines, each gaming machine having a display, and a server coupled to the plurality of gaming machines. Past payout data is stored on the server and an input device is configured to accept criteria from a player. A processor is structured to analyze the past payout data using the criteria input by the player such that particular past payout data is selected from the past payout data stored on the server to generate an indicia on the display, the indicia corresponding to the past payout data selected using the criteria input by the player such that the player can identify a gaming machine from among the plurality of gaming machines that is more likely to produce an outcome desired by the player.

Again, as conceded in the Office Action, Walker only discloses a plurality of gaming machines, a server coupled to the gaming machines, past play data stored on the server, an input device, and a processor. (Office Action, ¶6). Thus, since Walker does not disclose each and every feature of the independent system claims, Walker cannot anticipate these claims.

Further, the Examiner's reliance on In re Gulack is misplaced. Gulack dealt with the traditional doctrine that printed matter is not patentable subject matter. Under Gulack, printed or recorded matter may be given weight for obviousness purposes only if it bears a new and

functional relationship to a substrate on which it is printed. That is, that printed matter by itself does not constitute patentable subject matter does not mean that it can be ignored in making an obviousness determination. Thus, printed matter is given patentable weight if, but only if, it is functionally related to the substrate. Moreover, a printed matter rejection under 35 U.S.C. 103 stands on unquestionable legal and logical footing. See In re Lowry, 32 F.3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994).

“Functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. “Nonfunctional descriptive material” includes, but is not limited to, music, literary works, and a compilation or mere arrangement of data. That is, non-functional descriptive material is simply an abstract idea. M.P.E.P. § 2106.01.

Claim 1 is directed to a method for communicating a report concerning a gaming machine’s past payout data to a player to allow the player to identify a gaming machine that is more likely to produce an outcome desired by the player. Claim 35 is directed to a method for generating a report of a gaming machine’s past payout data to also allow the player to identify a gaming machine that is more likely to produce a desired outcome.

Any data or computer program being claimed by these claims is part of a computerized process where the computer executes the instructions set forth to achieve the desired results of the invention. Claims 1 and 35 are directed to particular methods and not mere program listings. Thus, these claims must be treated as process claims, and they must be considered in their entirety in determining whether they are directed to patentable subject matter. M.P.E.P § 2106.01. I, II. As discussed, Walker does not disclose or suggest the method of claim 1 and 35.

Therefore, it is respectfully submitted that Applicant’s claimed invention is not anticipated by nor would it have been obvious in view of Walker, either alone or in combination with other references.

Conclusion

In view of the foregoing, it is respectfully submitted that all the claims are now in condition for allowance. Accordingly, allowance of the claims at the earliest possible date is requested.

If prosecution of this application can be assisted by telephone, the Examiner is requested to call Applicant's undersigned attorney at (510) 663-1100.

If any fees are due in connection with the filing of this amendment (including any fees due for an extension of time), such fees may be charged to Deposit Account No. 504480 (Order No. IGT1P328).

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Respectfully submitted,

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